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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,539	05/02/2005	Katsuya Togawa	M&M-079-USA-PCT	1593
27955 7590 12/23/2009 TOWNSEND & BANTA c/o PORTFOLIO IP PO BOX 52050 MINNEAPOLIS, MN 55402				
EXAMINER				
DIRAMIO, JACQUELINE A				
ART UNIT		PAPER NUMBER		
1641				
MAIL DATE		DELIVERY MODE		
12/23/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/533,539

**Applicant(s)**

TOGAWA ET AL.

**Examiner**

JACQUELINE DIRAMIO

**Art Unit**

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 9, 10 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 11-15 and 17-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Claims***

1. Currently, claims 1 – 20 are pending. Claims 6 – 8, 11 – 15, and 17 – 20 are under examination. Claims 1 – 5, 9, 10, and 16 are acknowledged as withdrawn as drawn to non-elected inventions.

### ***Withdrawn Rejections***

2. All previous rejections of the claims under 35 U.S.C. 103(a) are withdrawn in view of Applicant's arguments filed August 19, 2009.

### ***Response to Arguments***

3. Applicant's arguments, see pages 2-5, filed August 19, 2009, with respect to the rejection(s) of the claim(s) under 35 U.S.C. 103(a) as being unpatentable over Kitajima et al. (US 5,876,605) in view of Kadoya, Voute et al., and Stone have been fully considered and are persuasive. In particular, Applicant's arguments that it would not have been obvious to combine the Kitajima et al. reference with Voute et al. in order to arrive at a membrane of less than 25% porosity given that the types of membranes differ between Kitajima et al. and Voute et al., and Kitajima et al. prefer much high porosities, is found persuasive. Secondly, Applicant's argument that it would not have been obvious to prepare the membrane of Kitajima et al. and Voute et al. with a mean surface roughness of not more than 100 nm in view of Stone, given that Stone et al. only teach of roughness of 5 microns or larger in order to prevent sticking of the red blood cells

to the surface, which is not relevant to Applicant's claimed membrane, is also found persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made and presented below.

## NEW GROUNDS OF REJECTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 6 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/635,239. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application's claim 6 and claim 1 of the copending application recite a

membrane for separating plasma or serum from blood, said membrane having a porosity of not more than 30% and a mean surface roughness of not more than 100 nm.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. However, it is acknowledged that the copending application has been allowed.

*Allowable Subject Matter*

5. Claims 7, 8, 11 – 15, and 17 – 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

6. No claims are allowed.

\*\*It is noted that in the event the obvious-type double patenting rejection over Applicant's claim 6 is overcome by Applicant, claims 6 – 8, 11 – 15 and 17 – 20 will be considered allowable. However, withdrawn claims 1 - 5, 9, 10 and 16, which have not been examined, are not considered allowable. Therefore, Applicant is requested to either amend or cancel these claims in their response to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACQUELINE DIRAMIO whose telephone number is (571)272-8785. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Shibuya can be reached on 571-272-0806. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jacqueline DiRamio/  
Examiner, Art Unit 1641

/GAILENE R. GABEL/  
Primary Examiner, Art Unit 1641

12/18/09

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